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Paper No. 4

SCOTT A HEIMERMANN
C/O JOAN HEIMERMANN
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COPY MAILED

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OFFICE OF PETITIONS

In re Application of
Scott Helmermann and
Stephen Danforth
Application No. 09/934,411
Filed: August 21, 2001
Title: FULLY AUTOMATED,
REQUISITION-DRIVEN, COMPETING
AUTHORIZED SUPPLIERS, WEB
SITE-BASED, REAL-TIME,
REVERSE-AUCTION, CENTRALIZED
E-PROCUREMENT SYSTEM FOR
GOVERNMENT, WITH BIFURCATED
INTERNAL AND EXTERNAL MODULES,
REQUISITION POOLING, ORDER
FORMULATION AND MANAGEMENT,
CONSOLIDATED IN-BOUND SHIPMENT AND
DISTRIBUTED J.I.T. DELIVERY,
PROCUREMENT-NEEDS PREDICTION,
CENTRALIZED CATALOG MANAGEMENT AND
NUMEROUS ADDITIONAL FEATURES

This is in response to the "PETITION OF JOINT INVENTOR, STEPHEN DANFORTH, TO FILE APPLICATION ON BEHALF OF JOINT INVENTOR, SCOTT A. HEIMERMANN," filed August 21, 2001, which is being treated as a petition under 37 CFR 1.47(a).

The petition under 37 CFR 1.47(a) is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventors. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on August 21, 2001, without a properly executed oath or declaration. Together with the filing of the application, applicant filed the instant petition under 37 CFR 1.47(a), to have joint inventor Stephen Danforth make the application for patent on behalf of joint inventor Scott A. Heimermann. The declaration appeared to have been executed by both Danforth and Heimermann. However, as detailed in the petition, the signature of Heimermann was actually made by his wife, Joan Heimermann.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor(s) cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 37 CFR 1.63; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor(s). The instant petition does not satisfy requirements (1), (2), (3), or (4).

As to requirement (1), there has been no showing that Scott A. Heimermann was presented with the application papers (specification, claims, drawings, oath or declaration). Regarding this, the Manual of Patent Examining Procedure states:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers.

It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray, 115 U.S.P.Q. 80 Comm'r Pat. 1956).

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient.¹ Petitioner stated that Heimermann wrote a letter in which he directed petitioner to send the application papers to Joan Heimermann. However, petitioner has not presented a copy of the letter on petition. On renewed petition, petitioner will need to present a copy of this letter from Scott A. Heimermann, evidencing his refusal to accept the application papers, or else must forward him a copy of the application papers.

As to requirement (2), petitioner has not submitted a proper 37 CFR 1.63 declaration. Where at least one joint inventor has signed a declaration, the signature block for the nonsigning inventors should be left **blank**. Such a declaration will be treated as having been signed by available joint inventor

¹ MPEP 409.03(d).

Danforth on behalf of non-signing inventor Heimermann.²

As to requirement (3), petitioner has not submitted the petition fee of \$130. On renewed petition, petitioner must submit this fee.

As to requirement (4), petitioner must state the last known address of non-signing inventor Heimermann. This address should be the last known address at which Heimermann customarily receives mail.³

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
 Commissioner for Patents
 P.O. Box 1450
 Alexandria VA 22313-1450

By FAX: (703) 308-6916
 Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
 2201 S. Clark Place
 Arlington, Virginia

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-0272.



Cliff Congo
Petitions Attorney
Office of Petitions

cc: Stephen Danforth
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² See MPEP 409.03(a).

³ See MPEP 409.03(e).